

Application No. 09/682,732
Art Unit 3728

REMARKS

We reply to the Office action mailed March, 2003. In that Office Action, claims 1-15, which were elected without traverse to the restriction on March 25, 2003, are rejected as being obvious over Yant (the '644 patent) in view of Brandon (the '679 patent) as well as Gates (the UK 221 patent), also in view of Brandon.

We previously canceled 5 claims, which included 1 independent claim. We have added 3 new claims 21-23, which includes 1 independent claim. Thus, we believe no fees are due. We have added no new matter to the application with the addition of these claims because claim 21 is a combination of claims 1, 3 and 6, claim 22 tracks claim 5, and claim 23 is a combination of claims 4 and 2, all of which were previously considered. The only additional language added to the independent claim (21) is the last clause, which reads "wherein said insert is removable and insertable into a shoe" and the adjective "planar," which modifies the stainless steel sheet (and is supported by paragraphs 29 and 36 in the application, where we describe how the sheet is stamped). We believe last clause is inherent in the term "insert" in the claim preambles, but we have added it to the newly presented claim in the event that it is not sufficiently clear in the existing claims.

We respectfully traverse the rejections made by the Office Action. We are unclear how the combination of the references cited in the Office Action somehow makes the claims obvious over the prior art. We claimed, for example:

An insert for footwear comprising:
a single steel sheet;
a cushion layer, shaped to the contour of the bottom of a foot and
including orthotic supports, disposed over the single steel sheet; and
a membrane secured to the cushion layer.

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(The remaining independent claims 7, 10, and 21 are narrower than claim 1, so we use claim 1 as a starting point.) The single steel sheet and shaped cushion layer are integral to the removable insert and are not part of a shoe construction.

With respect to paragraph 4 of the Office Action, we disagree with the rejection on at least the following grounds:

(1) Yant teaches a protective insole insert with at least three layers of flexible metal sheets, each layer having a thickness of at least 0.015 inches. However, we claim a multiple layer insole with a single sheet of steel (claims 1, 7, 10, and 21), and, for other claims (claims 6, 7, and 15), that the thickness must be between 0.020 and 0.025 inches. Yant teaches away from using a single sheet of steel, as well as having a thickness of less than 0.045 inches (or at best 0.030 inches). See for example Yant at approximately column 2, lines 30-34, and column 4.

(2) Brandon teaches a styled comfort shoe construction, which is integral to the shoe and not an insert. Thus, Brandon is part of the construction of the shoe and is not removable from the shoe, which is unlike an insert as claimed in our claims 1, 7 and 10. Brandon teaches many, many layers, the cushion layers being arranged in a unique sandwiching arrangement. See column 5, lines 41-62, for example.

It is not clear to us what precisely is combined in Yant and Brandon to yield what is claimed in our claims 1, 7, 10 and 21. The Office Action recites reference numerals from the patents as somehow teaching our claims, but it is not clear what those specific teachings are. The Office Action, in short, cites reference numbers from the patents, and then cites our claim language, but it does not cite textual support matching our claim language. For example, Yant is cited as disclosing a steel sheet (11), but in fact 11 is multiple steel sheets. Yant is also cited as teaching an orthopedic support (32), but in fact 32 is a raised metal arch (column 4, lines 27-29). Nevertheless, based on the two points [(1) and (2)] above concerning Yant and Brandon, it is believed that claims 1, 7, 10 and 21 are not obvious over Yant in view of Brandon – that there is no

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combination of Yant (a metal insert) and Brandon (a shoe construction) that yields what is claimed in claims 1, 7, 10 and 21. For these reasons, we believe that claims 2-6, 8-9, 11-14, and 21-23 are also patentable, and we respectfully traverse the Office Action statements concerning those claims as well.

We further respectfully disagree with the rejection of claims 6, 7 and 15. Yant, for the reasons cited in paragraph (1), teaches away from the limitation respecting the thickness of the single steel sheet. We claim a combination of elements, not merely a optimal work range for a single steel sheet used for an insert. This characterization of our claims we believe ignores the combination of other limitations that provide what we believe is the advancement to the art.

The Office Action rejects claims 2-5, 8, and 11-14, but provides no specific grounds for those rejections. Applicant respectfully requests that if grounds for rejection of claims 2-5, 8, and 11-14 are being made over Yant in view of Brandon, that the Patent Office kindly specify what those grounds are so that we may respond. Otherwise, we respectfully request that the rejection be withdrawn.

Claim 9 is dependent from claim 8, which is dependent from claim 7. It is unclear how claim 9 is rejected when no grounds for a rejection of claim 8 has been made. Applicant therefore respectfully traverses the rejection on claim 9 too. Furthermore, as with our traversal of the rejection of claims 6, 7, and 15, we traverse the rejection of claim 10. We again claim a combination of elements, not merely an optimal material.

In paragraph 5, the Office Action combines Gates in view of Brandon to yield our invention – or say that our invention is obvious in light of the two references. We respectfully traverse this rejection too. We note, at the outset, that a comparison of the rejection of paragraphs 4 and 5 are nearly identical to each other - it appears that the reference numerals have been replaced a few terms are changed.

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(3) Gates teaches a reinforcement device for footwear. Gates provides little to no specifics of his invention, so it is unclear what other than vague generalizations may be taken from Gates.

Brandon is discussed above in point (2) and we believe not on point for the same reasons recited there.

As with paragraph 4, it is not clear what precisely is combined in Gates and Brandon to yield what is claimed in our claims 1, 7 and 10. Based on points (2) and (3), above, it is believed that claims 1, 7, and 10 are not obvious over Gates in view of Brandon – that there is no combination of Gates (a reinforcement device) and Brandon (a shoe construction) that yields what is claimed in our claims. For these reasons, we believe that claims 2-6, 8-9, 11-14, and 21-23 are also patentable over the references cited, and we respectfully traverse the Office Action statements concerning those claims too.

We respectfully traverse the rejection of claims 6, 7 and 15. Gates, for the reasons cited in paragraph (3) provides no details of his invention resembling the numerous limitations of our claims, and in particular concerning the thickness of the single steel sheet. We claim a combination of elements, not merely a optimal work range for a single steel sheet used for an insert. The Patent Office characterization of our claims we believe ignores the other limitations that provide what we believe is the advancement to the art.

The Office Action rejects claims 2-5, 8, and 11-14, but provides no specific grounds for those rejections. We respectfully requests that if grounds for rejection of claims 2-5, 8, and 11-14 are being made over Gates in view of Brandon, that the Patent Office kindly specify what those grounds are so that we may respond. Otherwise, we respectfully request that the rejection be withdrawn.

Claim 9 is dependent from claim 8, which is dependent from claim 7. It is not clear how claim 9 is rejected when no ground for rejection of claim 8 has been made. We therefore respectfully traverses the rejection on claim 9 too. Furthermore, as with our traversal of the rejection of claims 6, 7, and 15, we

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traverse the rejection of claim 10. We again claim a combination of elements, not merely an optimal material.

We believe our remarks overcome the rejections by the Patent Office. If the problem with our claims is a wording problem, we respectfully request the Patent Office's assistance in identifying any wording that is not sufficiently clear so that we might better distinguish our claims over the prior art.

Respectfully submitted,



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